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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,322	09/17/2003	Nubar Ozbalik	EI-7610	4163
34769	7590	01/27/2006	EXAMINER	
DENNIS H. RAINEAR CHIEF PATENT COUNSEL, ETHYL CORPORATION 330 SOUTH FOURTH STREET RICHMOND, VA 23219			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,322

Applicant(s)

OZBALIK ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: ____ 11/25/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. It is noted that EP 646639 has been stricken from the IDS filed 11/25/05 as redundant given that the reference was already cited in the IDS filed 9/17/03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21, 31, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claims 1 and 12 each recite “major amount of a base oil” and “minor amount of an additive composition”. The scope of each of the claims is confusing because it is not clear what is meant by “major” or what amounts of base oil this encompasses and further because it is not clear what is meant by “minor” or what amounts of additive composition this encompasses.

(b) Claims 11, 21, 31, and 41 each recite “belt, chain, or disk-type continuously variable transmission”. The scope of the claim is confusing in light of the use of the word “type”. The addition of the word “type” extends the scope of the claims so as to render them indefinite since it is unclear what “type” is intended to convey. The addition of the word “type” to the otherwise definite expression renders the definite expression indefinite by extending its scope. *Ex parte*

Copenhaver, 109 USPQ 118 (Bd. App. 1955).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 9-17, 20-27, 30-37, and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Tagliamonte et al. (U.S. 6,528,458).

Tagliamonte et al. disclose method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising dialkyl hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, viscosity index modifier, and friction modifier, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid is used in clutch transmission to lubricate the slipping start-up clutch. Example 1 of Tagliamonte et al. discloses combining major amount of base oil and additive composition wherein it is calculated that the power transmitting fluid comprises 85% base oil, 0.09% dibutyl hydrogen phosphite, 0.42% antioxidant, 3.4% dispersant, and 0.04% antifoaming agent. Further, based on the amount of additives alone, it is calculated that the additive composition comprises approximately 0.6% dibutyl phosphite, 2.8%

antioxidant, 22.3% dispersant, and 0.04% antifoaming agent (col.1, lines 6-10, col.2, lines 5-7, col.9, lines 30-34, col.11, lines 27-27 and 60, and example 1). Given that Tagliamonte et al. disclose power transmitting fluid identical to that presently claimed including comprising additive composition identical to that presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dibutyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would inherently possess enhanced wear protection and enhanced anti-shudder durability as presently claimed and that the power transmitting fluid would inherently be suitable for use in a belt, chain, or disk-type continuously variable transmission as presently claimed.

In light of the above, it is clear that Tagliamonte et al. anticipate the present claims.

6. Claims 1-6, 9-17, 20-27, 30-37, and 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (U.S. 4,231,757) taken in view of the evidence given in Watts et al. (U.S. 6,660,695).

Davis discloses method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising dialkyl hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, viscosity index modifier, and diluent oil, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid is used in automatic transmissions, which are well known, as evidenced by Watts et al. (col.2, lines 13-18), to inherently contain slipping torque converter and wet clutch. Attention is called to Example A in col. 22 of Davis that discloses combining major amount of base oil and additives to form power transmitting fluid comprising

the base oil, 1% dispersant, 0.2% antioxidant, 0.077% dialkyl hydrogen phosphite, and 0.02% anti-foaming agent. It is calculated based on the amounts of additives alone, that the additive composition comprises approximately 8.6% dispersant, 1.7% antioxidant, 0.66% dialkyl hydrogen phosphite, and 0.17% anti-foaming agent (col.1, lines 9-16, col.18, lines 51, 57-58, and 63-66, and example A). Given that Davis discloses power transmitting fluid identical to that presently claimed including comprising additive composition identical to that presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dialkyl hydrogen phosphite as presently claimed, it is clear that the composition would inherently possess enhanced wear protection and enhanced anti-shudder durability as presently claimed and that the power transmitting fluid would inherently be suitable for use in a belt, chain, or disk-type continuously variable transmission as presently claimed.

In light of the above, it is clear that Davis anticipates the present claims.

7. Claims 1, 5-12, 16-22, 26-32, and 36-41 rejected under 35 U.S.C. 102(b) as being anticipated by EP 113199 taken in view of the evidence given in Watts et al. (U.S. 6,660,695).

EP 113199 disclose method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising 1 wt.% diolel hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, and friction modifier, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid is used in automatic transmissions, which are well known, as evidenced by Watts et al. (col.2, lines 13-18), to inherently containing slipping torque converter and wet clutch (page 1, lines 1-5 and 31-34, page 4, lines 4-10, page 4, line 39-page 5, line 17,

and page 6, lines 6 and 17). Given that EP 113199 discloses power transmitting fluid identical to that presently claimed including comprising additive composition identical to that presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dioleoyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would inherently possess enhanced wear protection and enhanced anti-shudder durability as presently claimed and that the power transmitting fluid would inherently be suitable for use in a belt, chain, or disk-type continuously variable transmission as presently claimed.

In light of the above, it is clear that EP 113199 anticipates the present claims.

8. Claims 1-6, 9-17, 20-22, 27, 30-37, and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Fyfe et al. (U.S. 2004/0129603) taken in view of the evidence given in Watts et al. (U.S. 6,660,695).

Fyfe et al. disclose method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising anti-wear compound such as dibutyl hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, viscosity index modifier, detergent, anti-rust additive, and friction modifier, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid comprises 0.01-6% anti-wear compound, 0.01-5% antioxidant, 0.1-20% dispersant, and 0.001-3% anti-foaming agent. It is disclosed that the power transmitting fluid is used in automatic transmission, which is well known, as evidenced by Watts et al. (col.2, lines 13-18), to inherently contain slipping torque converter and wet clutch (paragraphs 80, 136, 157-158, 163, 166, 172-173, 178, 191, 207, 219-220, and Table 3). Given that Fyfe et al. disclose

power transmitting fluid identical to that presently claimed including comprising additive composition identical to that presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dibutyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would inherently possess enhanced wear protection and enhanced anti-shudder durability as presently claimed and that the power transmitting fluid would inherently be suitable for use in a belt, chain, or disk-type continuously variable transmission as presently claimed.

In light of the above, it is clear that Fyfe et al. anticipates the present claims.

9. Claims 1-22 and 27-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Dasai (U.S. 5,064,546) taken in view of the evidence given in Watts et al. (U.S. 6,660,695).

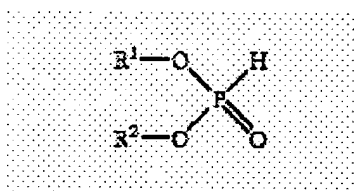
Dasai discloses method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising friction modifier such as diolel hydrogen phosphite, antioxidant, dispersant, and defoaming agent, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid comprises 0.01-5% friction modifier, 0.01-2% antioxidant, 0.1-10% dispersant, and 0.5 or 1% defoaming agent. It is disclosed that the power transmitting fluid is used in continuously variable transmission or automatic transmission, which is well known, as evidenced by Watts et al. (col.2, lines 13-18), to inherently contain slipping torque converter and wet clutch (col.1, lines 6-16, col.2, lines 40-42, col.3, lines 26-34, col.3, line 50-col.4, line 2, col.5, lines 30-33 and 35-66, col.5, line 68-col.6, line 1, and col.6, lines 30-39). Given that Dasai discloses power transmitting fluid identical to that presently claimed including comprising additive composition identical to that presently claimed, i.e. comprising antioxidant, anti-foaming agent,

dispersant, and dioleoyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would inherently possess enhanced wear protection and enhanced anti-shudder durability as presently claimed.

In light of the above, it is clear that Dasai anticipates the present claims.

10. Claims 1-3, 5-6, 9-14, 16-17, 20-23, 25-27, 30-34, 36-37, and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Sumiejeski et al. (U.S. 2005/0014656) taken in view of the evidence given in Watts et al. (U.S. 6,660,695).

Sumiejeski et al. disclose power transmitting fluid possessing improved wear resistance and anti-shudder properties wherein the power transmitting fluid is formulated by providing a major amount of base oil, providing a minor amount of an additive composition comprising hydrocarbyl phosphite of the formula:



wherein R^1 and R^2 are each hydrocarbyl groups including linear or branched alkyl group having 8 to 40 carbon atoms, antioxidant, dispersant, and defoaming agent, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid comprises 78-99.9% base oil, 0.1-5% hydrocarbyl phosphite, and 0-10% additives including dispersant, detergent, antioxidant, corrosion inhibitor, foam inhibitor and friction modifier. Attention is

called to example 1 that discloses power transmitting fluid comprising base oil, 0.2% dialkyl C16-C18 hydrogen phosphite, 2.25% dispersant, 2.2% antioxidant, and 55 ppm anti-foaming agent. Based on the additives alone, it is calculated that the additive composition comprises approximately 2.2% dialkyl hydrogen phosphite, 25.6% dispersant, 25% antioxidant, and 0.06% anti-foaming agent. It is further disclosed that the power transmitting fluid is used in automatic transmissions, which are well known, as evidenced by Watts et al. (col.2, lines 13-18), to inherently containing slipping torque converter and wet clutch (paragraphs 1, 34-38, 79, 85, 94-97, 101, 1101-11, 130-131, and 158). Given that Sumiejski discloses power transmitting fluid identical to that presently claimed including comprising additive composition identical to that presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and hydrocarbyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would inherently be suitable for use in a belt, chain, or disk-type continuously variable transmission.

In light of the above, it is clear that Sumiejski et al. anticipate the present claims.

11. Claims 1-6, 9-17, 20-22, 27, 30-37, and 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 646639 taken in view of the evidence given in Watts et al. (U.S. 6,660,695).

EP 646639 discloses method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising dialkyl C12-C28 hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, and corrosion inhibitor and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid is used in automatic transmissions, which are well known, as

evidenced by Watts et al. (col.2, lines 13-18), to inherently containing slipping torque converter and wet clutch. Example V of EP 646639 discloses combining major amount of base oil and additive composition wherein the power transmitting fluid comprises base oil, 0.9% dialkyl hydrogen phosphite, 0.1% antioxidant, 0.9% dispersant, and 0.05% antifoaming agent (page 2, lines 1-5 and 28-34, page 3, lines 6-13, page 10, lines 52-56, page 21, lines 25-34 and 42-44, and page 22, lines 1-5). Given that EP 646639 discloses power transmitting fluid identical to that presently claimed including comprising additive composition identical to that presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dialkyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would inherently possess enhanced wear protection and enhanced anti-shudder durability as presently claimed and would inherently be suitable for use in a belt, chain, or disk-type continuously variable transmission.

In light of the above, it is clear that EP 646639 anticipates the present claims.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 7-8, 18-19, 28-29, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagliamonte et al. (U.S. 6,528,458).

The disclosure with respect to Tagliamonte et al. in paragraph 5 is incorporated here by reference.

The difference between Tagliamonte et al. and the present claimed invention is the requirement in the claims of additive composition comprising dioleoyl hydrogen phosphite.

Example 1 of Tagliamonte et al. disclose the use of additive composition comprising dibutyl hydrogen phosphite, antioxidant, anti-foaming agent, and dispersant. However, there is no explicit disclosure of composition comprising dioleoyl hydrogen phosphite, antioxidant, anti-foaming agent, and dispersant as presently claimed.

However, col.6, lines 33-54 of Tagliamonte et al. disclose the use of fatty phosphite friction modifier of the formula $(RO)_2PHO$ wherein each R group has 8 to 24 carbon atoms and explicitly disclose that in one embodiment each R group is formed from oleyl group.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use dioleoyl hydrogen phosphite as the friction modifier in the power transmitting fluid of Tagliamonte et al. and thereby arrive at the claimed invention.

15. Claims 7-8, 18-19, 28-29, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (U.S. 4,231,757) in view of Tagliamonte et al. (U.S. 6,528,458).

The disclosure with respect to Davis in paragraph 6 above is incorporated here by reference.

The difference between Davis and the present claimed invention is the requirement in the claims of specific dihydrocarbyl phosphite.

Davis broadly discloses the use of dialkyl hydrogen phosphite.

Tagliamonte et al., which is drawn to power transmitting fluid, disclose the use of fatty phosphite friction modifier of the formula $(RO)_2PHO$ wherein each R group has 8 to 24 carbon atoms and explicitly disclose that in one embodiment each R group is formed from oleyl group. it is disclosed that the phosphite is used as a friction modifier (col.6, lines 33-54).

In light of the motivation for using dioleoyl hydrogen phosphite disclosed by Tagliamonte et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use dioleoyl hydrogen phosphite in the power transmitting fluid of Davis in order to produce fluid with desired friction properties, and thereby arrive at the claimed invention.

16. Claims 7-8, 18-19, 28-29, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumiejski et al. (U.S. 2005/0014656) in view of Dasai (U.S. 5,064,546)

The disclosure with respect to Sumiejski et al. in paragraph 10 is incorporated here by reference.

The difference between Sumiejski et al. and the present claimed invention is the requirement in the claims of specific dihydrocarbyl phosphite.

Dasai, which is drawn to power transmitting fluid, disclose the use of dioleyl hydrogen phosphite as a friction modifier. Dasai also discloses the equivalence and interchangeability of using dilauryl hydrogen phosphite as disclosed by Sumiejski et al. with using dioleyl hydrogen phosphite as presently claimed (col.3, line 50-col.4, line 8).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use dioleyl hydrogen phosphite in the power transmitting fluid of Sumiejski et al. in order to produce fluid with desired friction properties, and thereby arrive at the claimed invention.

17. Claims 7-8, 18-19, 28-29, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fyfe et al. (U.S. 2004/0129603) in view of Nelson et al. (U.S. 6,884,855)

The disclosure with respect to Fyfe et al. in paragraph 8 is incorporated here by reference.

The difference between Fyfe et al. and the present claimed invention is the requirement in the claims of specific dihydrocarbyl phosphite.

Nelson et al., which is drawn to power transmitting fluid, disclose the use of dioleyl hydrogen phosphite in order to improve antiwear and extreme pressure properties. Nelson et al.

also disclose the equivalence and interchangeability of using dibutyl hydrogen phosphite disclosed by Fyfe et al. with using dioleoyl hydrogen phosphite as presently claimed (col. 11, lines 19-20 and 30-31).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use dioleoyl hydrogen phosphite in the power transmitting fluid of Fyfe et al. in order to produce fluid with good antiwear and pressure properties, and thereby arrive at the claimed invention.

18. Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasai (U.S. 5,064,546) or Fyfe et al. (U.S. 2004/0129603).

The disclosure with respect to Fyfe et al. and Dasai in paragraphs 8 and 9 above are incorporated here by reference.

The difference between Fyfe et al. or Dasai and the present claimed invention is the requirement in the claims of amounts of dispersant, antioxidant, dihydrocarbyl hydrogen phosphite, and defoaming agent in the additive composition.

There is no explicit disclosure in Fyfe et al. or Dasai of the amounts of dispersant, antioxidant, dihydrocarbyl hydrogen phosphite, and defoaming agent in the additive composition. However, Dasai does disclose that the power transmitting fluid comprises 0.01-5% dioleoyl hydrogen phosphite, 0.5-15% viscosity index improver, 0.01-2% antioxidant, 0.1-10% dispersant, and 0.5 or 1% defoaming agent while Fyfe et al. disclose that the power transmitting fluid comprises 0.01-6% dibutyl hydrogen phosphite, 0.01-5% antioxidant, 0.1-20% dispersant, and 0.001-3% anti-foaming agent. Based on these amounts, it is calculated that the additives

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comprise approximately 0.03-82% dioleoyl hydrogen phosphite, 0.03-65% antioxidant, 0.4-90% dispersant, and 1.5-62% defoaming agent in Dasai and approximately 0.03-84% dibutyl phosphite, 0.03-83% antioxidant, 0.7-99% dispersant, and 0.003-75% anti-foaming agent in Fyfe et al.

As set forth in MPEP 2144.05, in the case where the claimed range “overlap or lie inside ranges disclosed by the prior art”, a *prima facie* case of obviousness exists, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

In light of the overlap between the amounts of dihydrocarbyl hydrogen phosphite, antioxidant, dispersant, and defoaming agent disclosed by Dasai or Fyfe et al. and those presently claimed, it therefore would have been obvious to one of ordinary skill in the art, absent evidence to the contrary, to choose any amount of dihydrocarbyl hydrogen phosphite, antioxidant, dispersant, and defoaming agent, including those presently claimed, in Dasai or Fyfe et al. order to control the properties of the power transmitting fluid, and thereby arrive at the claimed invention.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alexander et al. (U.S. 2004/0154958), Deckman et al. (U.S. 2004/0038833), and Tipton (U.S. 6,372,696) each disclose power transmitting fluid comprising base oil, dialkyl hydrogen phosphite, antioxidant, dispersant, and anti-foaming agent.

Watts et al. (U.S. 6,534,451) disclose power transmission fluid comprising base oil, dispersant, and antioxidant, however, there is no disclosure that the power transmission fluid comprises dialkyl hydrogen phosphite. Rather, Watts et al. disclose the use of antiwear additive formed by reacting dialkyl hydrogen phosphite with sulfur to produce monothiophosphite which is then neutralized with amine.


Vinci (U.S. 6,468,946) discloses power transmitting fluid comprising base oil, dialkyl hydrogen phosphite, and additives that include dispersant, antioxidant, and anti-foaming agent, however, there is no explicit disclosure of composition comprising dialkyl hydrogen, dispersant, antioxidant, and anti-foaming agent as presently claimed.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
1/21/06